

AMENDMENT AND RESPONSE TO
RESTRICTION REQUIREMENT
U.S. Application No. 10/565,533

REMARKS

This responds to the Restriction Requirement, dated September 22, 2010. In this Amendment, claims 1 and 13 have been amended, and claims 56-65 have been cancelled. No new matter has been added.

Restriction and Election Requirements

A restriction requirement has been imposed by the Examiner. In particular, the Examiner is requiring a restriction requirement to the following claim groups: Group I, claims 56-65; Group II, claims 1-12 and 66; Group III, claims 13-36 and 67; and, Group IV, claims 37-55. The Examiner also requires an election of species to the following species: a type of anisotropy selected from magnetic crystalline anisotropy or shape anisotropy. For the record, Applicant points out that the election requirement states that claim 1 is generic.

Applicant respectfully traverses the restriction requirement, but has provisionally elected Group IV, claims 37-55. Applicants have cancelled the Group I claims, claims 56-65. Applicants have amended the Group II claims and the Group III claims. The Group II claims and the Group III claims, as amended, do form a single general inventive concept under PCT Rule 13.1.

The Group II-Group IV claims, claims 1-55 and 66-67, have a technical relationship among the claimed inventions involving the same or corresponding special technical features. Specifically, the common technical feature shared by claims 1-55 and 66-67 is *the rotation of the magnetic particles having intrinsic magnetization in a material for destruction of the material, the magnetization of the magnetic particles being stabilized by inherent magneto-crystalline*

AMENDMENT AND RESPONSE TO
RESTRICTION REQUIREMENT
U.S. Application No. 10/565,533

anisotropy and/or shape anisotropy. The Examiner has not pointed to any teaching in the cited art for this common technical feature. The Examiner's identification of the common technical feature was incorrect – the Examiner indicated that magnetic particles alone were the common technical feature. As a result, the Examiner has only identified Sun which according to the Examiner describes “a magnetic nanocomposite having high magneto crystalline anisotropy” and Zing which according to the Examiner describes “shape controlled synthesis of magnetic iron oxide nanoparticles.” See page 3 of the Office Action. However, neither Sun nor Zing disclose the common technical feature of the rotation of a magnetic particle. Accordingly, restriction to one of Groups II-IV is improper and the Examiner should examine each of claims 1-55 and 66-67.

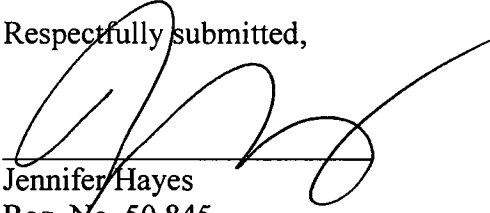
Applicant also respectfully traverses the election of species requirement, and provisionally elects the magneto-crystalline species. The magneto-crystalline species is at least covered by Claims 1-11, 13-26, 28-54. Under the PCT rules, Markush groups are similar (i.e., not subject to election) if all the alternatives have a common property and a common structure is present. Magneto-crystalline anisotropy and shape anisotropy are similar because they share a common property (i.e., they both stabilize magnetization of the magnetic particle), and they have a common structure (i.e., they are both anisotropic magnetic particles). Accordingly, it is improper for the Examiner to require election to one of magneto-crystalline anisotropy and shape anisotropy.

AMENDMENT AND RESPONSE TO
RESTRICTION REQUIREMENT
U.S. Application No. 10/565,533

Should the Examiner choose to maintain the restriction of species and makes the restriction final, then this paper is to be treated as a petition to the Director under 37 C.F.R. §1.183 to waive such rules as necessary, in the interests of justice, to prevent an unnecessary extinguishment of the Applicant's rights as detailed above. Any fees associated with the petition may be charged to our deposit account as set forth below. Alternatively, the Applicant reserves the right to pursue the claims of any other species in a divisional application.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 50-3557. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Jennifer Hayes
Reg. No. 50,845

Dated: November 23, 2010

Nixon Peabody LLP
P.O. Box 60610
Palo Alto, CA 94306
Tel. (650) 320-7700
Fax. (650) 320-7701